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OFFICE OF PETITIONS

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|------------------------------|---|-------------------------|
| In Application of | : | |
| Ramakrishnan et al. | : | DECISION ON APPLICATION |
| Application No. 09/003,810 | : | FOR |
| Filed: January 7, 1998 | : | PATENT TERM ADJUSTMENT |
| Atty Docket No. 44481-5017-0 | : | |

This is in response to the STATEMENT OF FACTS UNDER 37 C.F.R. 1.705(b)(2), filed December 9, 2005. Applicants request reconsideration of patent term adjustment of seven hundred sixty-one (761) days indicated on the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) attached to the Notice of Allowance and a reinstatement of the missing patent term of 360 (three hundred and sixty) days for a total PTA of 1121 (one thousand one hundred and twenty-one) days.

The application for patent term adjustment is **GRANTED**.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is one thousand one hundred twenty-one (1121) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On September 21, 2005, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 761 days. The instant request was

timely filed on the same date as payment of the Issue Fee. Applicants request a total of 360 additional days of PTA for

- 1) a 348 day Office delay in mailing a notice of allowance more than four months after a favourable interference decision, and
- 2) a 12 day Office delay in mailing a first Office action after the filing date of the continued prosecution application.

Applicants state that the patent issuing from this application is not subject to a terminal disclaimer.

Applicants are entitled to a period of adjustment for Office delay in taking action after the final decision by the Board. Specifically § 1.703(a)(5) provides for a period of adjustment for Office delay for:

The number of days, if any, in the period beginning on the day after the date that is four months after the date of a final decision by the Board of Patent Appeals and Interferences or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145 or 146 where at least one allowable claim remains in the application and ending on the date of mailing of either an action under 35 U.S.C. 132 or a notice of allowance under 35 U.S.C. 151, whichever occurs first;

A favorable decision in the interference proceeding was entered on June 8, 2004. The notice of allowance under 35 U.S.C. 151, mailed September 21, 2005, was mailed in response to the favorable decision. Pursuant to § 1.703(a)(5), a period of adjustment of 348 days, for the period from October 9, 2004 to September 21, 2005, should have been entered.

Applicants are correct that a period of 12 days should have been entered pursuant to 37 CFR 1.703(a)(1). The date of mailing of a first action under 35 U.S.C. 132 is May 9, 2002. That is outside the 14 months of the filing date of the application, February 27, 2001, by 12 days. Thus, a period of adjustment of 12 days is being entered pursuant to 1.702(a)(1).

Applicants state they engaged in reasonable efforts to conclude prosecution of the application. However, a review of the record indicates possible basis for entry of a period of reduction. Specifically, § 1.704(c) provides that:

Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping:

- (1) Suspension of action under § 1.103 at the applicant's request, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the date a request for suspension of action under § 1.103 was filed and ending on the date of the termination of the suspension;

The prosecution history is unclear as to the extent to which, if at all, the prosecution of this application was delayed due to suspension of action under § 1.103 at applicant's request. However, on March 12, 2002, the Office mailed a communication stating that the request for deferral/suspension of action under 37 CFR 1.103 has been approved. Further, in the communication it was noted that the application was previously suspended on May 21, 2001. Yet, no letter requesting suspension of action at the applicant's request is present in the application file. Accordingly, no reduction is presently being entered on this basis. However, applicants are reminded of their duty of good faith and candor to the Office. See Comment 43 of *Changes to Implement Patent Term Adjustment under Twenty-Year Patent Term; Final Rule*, 65 Fed. Reg. 54366 (September 18, 2000). Pursuant to Comment 43, if the patent issues with more patent term adjustment than it is due because of the failure of the Office to enter a reduction for suspension at applicant's request or on any other basis, patentees should so advise the Office.

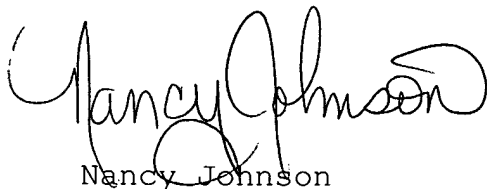
In view thereof, the correct determination of patent term adjustment at the time of the mailing of the notice of allowance is 1121 days.

Applicants are reminded that the patent will issue with a revised patent term adjustment. This revised PTA will include, as appropriate, periods of adjustment for the delay in issuing the patent after payment of the issue fee and satisfaction of all outstanding requirements; and for the Office's failure to issue the patent within 3 years of its filing date.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The Office of Patent Publication has been advised of this decision. The application is, thereby, being forwarded to the Office of Patent Publication for issuance of the patent.

Telephone inquiries specific to this matter should be directed to the undersigned at (571) 272-3219.

A handwritten signature in black ink, appearing to read "Nancy Johnson". The signature is fluid and cursive, with the first name "Nancy" and last name "Johnson" clearly distinguishable.

Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Enclosure: Copy of REVISED Pair Screen

PTA Calculations for Application: 09/003810

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|--------------------------|------------|-------------------------|------|
| Application Filing Date: | 01/07/1998 | PTO Delay (PTO): | 761 |
| Issue Date of Patent: | | Three Years: | 0 |
| Pre-Issue Petitions: | 0 | Applicant Delay (APPL): | 0 |
| Post-Issue Petitions: | 0 | Total PTA (days): | 1121 |
| PTO Delay Adjustment: | 360 | | |

File Contents History

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EXPLANATION OF PTA CALCULATION